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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,854	04/21/2004	Peter Stadler	A-2408	6217
24131	7590	02/15/2005	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			FUNK, STEPHEN R	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/828,854

Applicant(s)

STADLER ET AL.

Examiner

Stephen R. Funk

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 and 10-12 is/are allowed.
- 6) ☒ Claim(s) 13-25 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/531,344.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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Newly submitted claim 26 is directed to an invention that is independent or distinct from the invention originally claimed in the patent for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 - 25, drawn to a method of printing, classified in class 101, subclass 485.
- II. Claim 26, drawn to a printing apparatus, classified in class 101, subclass 183.

The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus could be used to print overlapping multicolor images.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since the subject matter of the original patent claims is drawn to a method of printing, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 26 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP §§ 821.03, 1450.

Claims 1 - 25 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process

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which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed. Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251.

The disclosure is objected to because of the following informalities: In column 7 lines 2 and 6 reference numeral "6" should be --3-- and in column 7 lines 4 and 8 reference numeral "7" should be --4--. Appropriate correction is required.

Claim 9 is objected to because of the following informalities:

In claim 9 lines 1 - 2 "the final printing step" lacks any clear antecedent basis.

Appropriate correction is required.

Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for the clear varnish being a "dispersion" varnish as is now recited in claim 22. See column 3 lines 25 - 30 and 34 - 38 and column 8 lines 63 - 67 in the patent.

Claim 22 is rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent

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is as follows: The specification does not provide support for the clear varnish being a “dispersion” varnish as is now recited in claim 22.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 - 19 and 21 - 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeMoore et al. (US 5,651,316) in view of Sismanis et al. (US 6,042,888).

DeMoore et al. teach a printing method comprising printing a printing material in a combined printing process (column 1 lines 11 - 17), printing with a first ink system (column 5 lines 49 - 59, column 6 lines 64 - column 7 line 13) onto a first printing area, printing with a second ink system (column 7 lines 14 - 38) onto a second printing area, wherein at least one of the first and second ink systems is a radiation curing ink (column 3 lines 1 - 5, column 5 lines 37 - 55, and column 16 lines 40 - 44), and subsequently covering the first and second printing areas with a closed layer of clear varnish (column 1 lines 15 and 46 - 55, column 6 lines 49 - 54, column 16 line 64 - column 17 line 4, and column 18 lines 49 - 61). It is inherent that the protective layer of DeMoore et al. is clear since, otherwise, the first and second printing areas would not be viewable after the protective layer is applied at the end of the printing process. DeMoore et al. do not specifically teach that the first printing area “adjoins” the second printing area.

Sismanis et al. teach a similar method wherein the first printing area adjoins the second printing area (column 2 lines 65 - 66, column 4 lines 64 - 67, column 5 lines 17 - 19 and 28 - 31,

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column 6 lines 5 - 7, and column 7 lines 41 - 42). Further note the clear protective layer of Sismanis et al.

It would have been obvious to one of ordinary skill in the art to provide the method of DeMoore et al. with the step of printing the second area adjoining the first printing area in view of Sismanis et al. so as to more economically utilize an expensive first ink. See, for example, column 5 lines 21 - 23 of Sismanis et al.

With respect to claims 14 and 15 see column 3 lines 1 - 5, column 5 lines 37 - 55, and column 16 lines 40 - 44 of DeMoore et al.

With respect to claims 16 and 17 see the paragraph bridging columns 6 and 7, the paragraph bridging columns 15 and 16, and column 16 lines 28 - 39 of DeMoore et al.

With respect to claims 18, 19, and 21 see column 5 lines 40 - 43 and column 7 lines 14 - 39 of DeMoore et al.

With respect to claims 22 and 23 see column 1 lines 15 and 46 - 55, column 6 lines 49 - 54, column 16 line 64 - column 17 line 4, and column 18 lines 49 - 61 of DeMoore et al.

With respect to claim 24 see column 6 line 64 - column 7 line 38 and Figures 1 and 3 of DeMoore et al.

With respect to claim 25 see column 6 line 19+ of DeMoore et al.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeMoore et al. in view of Sismanis et al. as applied to the claims above, and further in view of Kistler et al. (US 5,791,251). DeMoore et al. do not teach using a specially mixed ink. Kistler et al. teach using a specially mixed ink different from the colors black, cyan, magenta, and yellow in an offset printing press. See column 2 lines 8 - 13, column 4 lines 28 - 30, and column 5 lines 61 - 65 of

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Kistler et al. It would have been obvious to one of ordinary skill in the art to provide the method of DeMoore et al., as modified by Sismanis et al., with the step of using a specially mixed color in view of Kistler et al. so as to obtain special effects on the printing material.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. With respect to a dispersion varnish, see the Abstract of Edwards et al. ('681), for example.

Claims 1 - 8 and 10 - 12 are allowed. With respect to the allowability of parent claim 1 see applicant's Remarks filed August 23, 2001 and the Office action mailed October 16, 2001 in parent application Serial No. 09/531,344.

Claim 9 would be allowable if rewritten or amended to overcome the objection(s) set forth in this Office action.

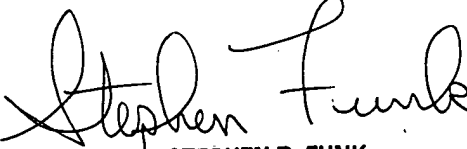
The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen R. Funk whose telephone number is (571) 272-2164.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (571) 272-2168.

The fax phone number for ALL official papers is (703) 872-9306. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner at (571) 273-2164.

SRF  
February 9, 2005

  
**STEPHEN R. FUNK**  
**PRIMARY EXAMINER**